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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/017,329	02/02/1998	RYUICHI MATSUKURA	1083.1049/JD	8159
21171	7590	09/21/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			CARDONE, JASON D	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/017,329	Applicant(s) MATSUKURA, RYUICHI	
	Examiner Jason D Cardone	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 16-25 is/are pending in the application.
- 4a) Of the above claim(s) 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Attached Office Action</u> . |

DETAILED ACTION

1. This action is responsive to the remarks of the applicant, filed on 6/7/04. Claims 1-11 and 16-25 are presented for examination.

2. Claims 23-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/7/04.

3. The amendment to the claims (the cancellation of claims 23-25 filed on 6/7/04 does not comply with the requirements of 37 CFR 1.121(c) because the amendment does not have all the claims presented in a claim list. Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) *Claims*. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing*. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1-5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

Art Unit: 2145

Since the restriction reply filed on 6/7/04 appears to be *bona fide*, examiner has withdrawn claims 23-25 from further prosecution. Applicants are reminded to cancel withdrawn claims in accordance with the requirements of 37 CFR 1.121.

4. Claims 1-11 and 16-22 presented for further examination.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11 and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yacoub, U.S. Patent No. 6,552,813, in view of Carpenter et al. (hereinafter Carpenter), U.S. Patent No. 6,477,581.
7. Regarding claim 1, Yacoub discloses a computer network system in which plural connecting means is provided in a network circuit to which a first computer has been connected, and a second computer is connected to one of the connecting means, wherein; the first computer comprises resource information managing means for managing information relating to hardware or software, including a position in the real world for each of the hardware or software, which are usable through the network circuit, and resource information processing means for taking out the content of the resource information managing means in response to a request of information relating

Art Unit: 2145

to usable hardware or software from another computer, and transmitting to the network circuit [ie. the server, Yacoub, col. 5, line 35 – col. 7, line 9 and col. 10, lines 28-65];

the second computer comprises resource setting means for setting the hardware or software according to the content of the hardware or software information transmitted by the resource information processing means of the first computer [ie. the client with virtual printer, Yacoub, col. 4, line 28 – col. 5, line 13 and col. 11, lines 1-52]; and

when the second computer is connected to the network circuit through any one of the plural connecting means, the resource setting means receives the content of the hardware or software information transmitted by the resource information processing means of the first computer and sets the hardware or software [Yacoub, col. 4, line 28 – col. 5, line 13 and col. 6, lines 46-65].

Yacoub does disclose the use of portable data assistant (PDA) does not specifically disclose connecting means capable of connecting and disconnecting a computer. However, Carpenter, in the same field of endeavor, discloses connecting means capable of connecting and disconnecting a computer [Carpenter, col. 3, line 48 – col. 4, line 40 and col. 5, lines 12-44]. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate connections means for portable devices, disclosed by Carpenter, in the network system, disclosed by Yacoub, in order to have user-friendly connection [Carpenter, col. 1, line 62 – col. 2, line 9].

8. Regarding claim 2, claim 2 has similar limitations as claim 1 and additional limitations of a resource installation position managing means for managing the position

at which the resource managed by the resource information managing means exists and selecting an arbitrary resource. Therefore, the similar limitations are disclosed under Yacoub-Carpenter for the same reasons set forth in the rejection of claim 1 [Supra 1]. Also, Yacoub-Carpenter further discloses the resource installation position managing means for managing the position at which the resource managed by the resource information managing means exists and selecting an arbitrary resource [Yacoub, col. 10, lines 28-65].

9. Regarding claim 3, claim 3 has similar limitations as claim 1 and additional limitations of a resource information holding means for holding the resource information relating to the resources that can be managed directly and comparing means for comparing the content of the resource information holding means and the content of the resource information managing means of the first computer, detecting a replaceable resource. Therefore, the similar limitations are disclosed under Yacoub-Carpenter for the same reasons set forth in the rejection of claim 1 [Supra 1]. Also, Yacoub-Carpenter further discloses resource information holding means for holding the resource information relating to the resources that can be managed directly and comparing means for comparing the content of the resource information holding means and the content of the resource information managing means of the first computer, detecting a replaceable resource [Yacoub, col. 6, line 46 – col. 7, line 9].

10. Regarding claim 5, claim 5 has similar limitations as claim 1 and additional limitations of a resource information holding means for holding the resource information relating to the resources that can be managed directly and comparing means for comparing the content of the resource information holding means and the content of the resource information managing means of the first computer, detecting a replaceable resource. Therefore, the similar limitations are disclosed under Yacoub-Carpenter for the same reasons set forth in the rejection of claim 1 [Supra 1]. Also, Yacoub-Carpenter further discloses resource information holding means for holding the resource information relating to the resources that can be managed directly and comparing means for comparing the content of the resource information holding means and the content of the resource information managing means of the first computer, detecting a replaceable resource [Yacoub, col. 6, line 46 – col. 7, line 9].

11. Regarding claim 6, claim 6 has similar limitations as claim 1 and additional limitations of a resource updating means for updating the content of the resource information managing means when receiving an updated resource. Therefore, the similar limitations are disclosed under Yacoub-Carpenter for the same reasons set forth in the rejection of claim 1 [Supra 1]. Also, Yacoub-Carpenter further discloses a resource updating means for updating the content of the resource information managing means when receiving updated resource information [Yacoub, col. 2, lines 25-29 and col. 6, lines 32-42].

Art Unit: 2145

12. Regarding claims 10 and 11, claims 10-11 has similar limitations as claim 1 and additional limitations of a resource noticing means for noticing the content of the resource information managing means and updating resource information registering means by receiving the updated resource information from the computer. Therefore, the similar limitations are disclosed under Yacoub-Carpenter for the same reasons set forth in the rejection of claim 1 [Supra 1]. Also, Yacoub-Carpenter further discloses a resource noticing means for noticing the content of the resource information managing means and updating resource information registering means by receiving the updated resource information from the computer [Yacoub, col. 2, lines 25-29 and col. 6, lines 32-42].

13. Regarding claims 4, 7-9 and 16-22, claims 4, 7-9 and 6-22 have similar limitations as claim 1. Therefore, they are rejected under Yacoub-Carpenter for the same reasons set forth in the rejection of claim 1 [Supra 1].

Response to Arguments

14. Applicant's arguments filed 2/25/04 have been fully considered but they are not persuasive.

15. (A) Yacoub does not disclose resource information processing means is an element of the first computer.

As to point (A), Yacoub does disclose that the server (not the client) has resource information processing means. Yacoub discloses that once the client sends print job to the server, it is the server that decides which printer is available for the print job [Yacoub, col. 5, lines 35-63 and col. 6, lines 54-67]. During patent examination and prosecution, claims must be given their broadest reasonable interpretation. *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993); *In re Prater*, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). Giving the instant claims their broadest reasonable interpretation, "resource information processing means" is broad enough to read on the server deciding on a printer as disclosed in Yacoub.

16. (B) The alleged motivation of Carpenter relates to improving an already-existing connection, not establishing a new connection.

As to point (B), Carpenter does disclose connecting means capable of connecting and disconnecting a computer [Carpenter, col. 3, line 48 – col. 4, line 40 and col. 5, lines 12-44]. Carpenter discloses the use of PDAs, also shown by Yacoub [Yacoub, col. 11, lines 1-19], that connect to servers [Carpenter, col. 4, line 1-64]. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate show detail of connections means for portable devices, disclosed by Carpenter, in the network system, disclosed by Yacoub, in order to have user-friendly connection [Carpenter, col. 1, line 62 – col. 2, line 9]. Carpenter discloses setting up connections [Carpenter, col. 2, lines 1-9]. It is noted that the features upon which applicant relies (i.e., establishing a new connection) are not recited in the rejected

claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

17. (C) Carpenter does not disclose position in the real world of hardware or software.

As to point (C), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In determining obviousness, furthermore, references are read not in isolation but for what they fairly teach in combination with the prior art as a whole. *Id.* at 1097, 231 USPQ at 380. It is the combination Yacoub-Carpenter rather than Carpenter alone that discloses the instant claimed subject matter. Yacoub substantially discloses the instant claimed subject matter. Yacoub does disclose the use of portable data assistant (PDA) does not specifically disclose connecting means capable of connecting and disconnecting a computer. However, Carpenter, in the same field of endeavor, discloses connecting means capable of connecting and disconnecting a computer [Carpenter, col. 3, line 48 – col. 4, line 40 and col. 5, lines 12-44]. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate connections means for portable devices, disclosed by Carpenter, in the network system, disclosed by Yacoub, in order to have user-friendly connection.

Conclusion

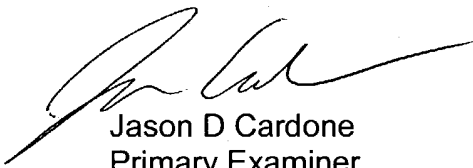
18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D Cardone whose telephone number is (703) 305-8484. The examiner can normally be reached on Mon.-Thu. (9AM-6PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone
Primary Examiner
Art Unit 2145

September 17, 2004